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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,738	09/11/2003	Paul Watts	P08042US00/BAS	3454

881 7590 01/18/2007  
STITES & HARBISON PLLC  
1199 NORTH FAIRFAX STREET  
SUITE 900  
ALEXANDRIA, VA 22314

EXAMINER
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WONG, EDNA

ART UNIT	PAPER NUMBER
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1753

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/659,738

Applicant(s)

WATTS ET AL.

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

This is in response to the Amendment dated November 30, 2006. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Arguments***

#### **Specification**

I. The abstract of the disclosure has been objected to.

The objection of the abstract of the disclosure has been withdrawn in view of Applicants' amendment.

II. The disclosure has been objected to because of minor informalities.

The objection of the disclosure has been withdrawn in view of Applicants' amendment.

#### **Claim Rejections - 35 USC § 112**

Claims **14 and 27** have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 14 and 27 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicants' amendment.

Claim Rejections - 35 USC § 102

I. Claims **1-2, 5-7 and 10-11** have been rejected under 35 U.S.C. 102(b) as being anticipated by **Law, Jr. et al.** (US Patent No. 6,238,543 B1).

The rejection claims 1-2, 5-7 and 10-11 under 35 U.S.C. 102(b) as being anticipated by Law, Jr. et al. has been withdrawn in view of Applicants' remarks.

II. Claims **15, 18-20 and 23-24** have been rejected under 35 U.S.C. 102(b) as being anticipated by **Law, Jr. et al.** (US Patent No. 6,238,543 B1).

The rejection of claims 15, 18-20 and 23-24 under 35 U.S.C. 102(b) as being anticipated by Law, Jr. et al. has been withdrawn in view of Applicants' remarks.

Claim Rejections - 35 USC § 103

I. Claims **1-14** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Meresz et al.** (US Patent No. 4,006,065) in combination with **Haswell et al.** (US Patent No. 6,989,090 B2) ['090] and **Haswell, S. J.** ("Development and Operating Characteristics of Micro Flow Injection Analysis Systems Based on Electroosmotic Flow", *Analyst* (January, 1997), Vol. 122, pp. 1R-10R).

The rejection of claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over Meresz et al. in combination with Haswell et al. ['090] and Haswell, S. J. is as applied in the Office Action dated July 31, 2006 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that in micro-reactors, reactions take place in the channels between the electrodes - not at the electrode surfaces. In view of this, the skilled person simply would not have attempted to use the Meresz reaction in a micro-reactor because the skilled person would have understood that the Meresz reaction takes place at the anode surface, and so the skilled person would have reasoned that the reaction would not have taken place at all in the micro-reactor.

In response, the Kolbe type reaction disclosed by Meresz can be performed in a micro-reactor because the chemical reaction at an electrode surface would have been the same as the chemical reaction in a fluid of a micro-reactor because Haswell teaches that it is known to perform chemical reactions in micro-reactors (col. 1, lines 7-21). The surface of the channel would have been anodically charged.

The motivation to combine prior art references can arise from the expectation that the prior art elements will perform their expected functions to achieve their expected results when combined for their common known purpose. *In re Floyd Appeal* No. 94-1071, slip op. At page 4 (Fed. Cir. July 20, 1994) and MPEP § 2144.07.

The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success (MPEP § 2143.02).

Furthermore, there is no requirement that the motivation to make the combination be expressly articulated in one or more of the references. The teaching, suggestion or inference can be found not only in the references but also from knowledge generally available to one of ordinary skill in the art. *Ashland Oil v. Delta Resins* 227 USPQ 657

(CAFC 1985). The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin* 170 USPQ 209 (CCPA 1971); *In re Rosselet* 146 USPQ 183 (CCPA 1960). References are evaluated by what they collectively suggest to one versed in the art, rather than by their specific disclosures. *In re Simon* 174 USPQ 114 (CCPA 1972); *In re Richman* 165 USPQ 509, 514 (CCPA 1970).

II. Claims **15-27** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Meresz et al.** (US Patent No. 4,006,065) in combination with **Haswell et al.** (US Patent No. 6,989,090 B2) ['090] and **Haswell, S. J.** ("Development and Operating Characteristics of Micro Flow Injection Analysis Systems Based on Electroosmotic Flow", *Analyst* (January, 1997), Vol. 122, pp. 1R-10R).

The rejection of claims 15-27 under 35 U.S.C. 103(a) as being unpatentable over Meresz et al. in combination with Haswell et al. ['090] and Haswell, S. J. is as applied in the Office Action dated July 31, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above and incorporated herein.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

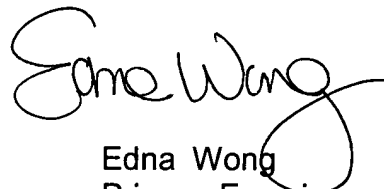
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Edna Wong  
Primary Examiner  
Art Unit 1753

EW  
January 9, 2007